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EXAMINER	
JANVIER, JEAN D	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/043,697	JACOBS, CARL R.	
	Examiner	Art Unit	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-28 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/18/2007 has been entered and a Non-Final Action follows.

Response To Applicant's Arguments

Applicant's arguments with respect to the claimed invention have been considered but are moot in view of the new ground(s) of rejection.

Specification

General Comments

Regarding claim 10, "providing the available discounted service to the customer at no charge if the customer does not purchase any fuel" should apparently be - -providing the available discounted service to the customer at no charge **even** if the customer does not purchase any fuel- -.

It appears that claim 16 should be re-written as a computer readable medium storing instructions, when executed on a processor, perform the necessary steps.

Status of the claims

Claims 1-28 are pending in the Instant Application while claims 1-58 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9, 16 and 20 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the Application was filed, had possession of the claimed invention.

Here, although the specification recites that the criteria by which the customers are provided with discounted and/or free services may be reprogrammed to thereby **permit the operator of the system to focus upon particular target groups of customers for increased sales and that** the identity of the customer can be determined in more general terms, for example, to **group the customer together with other similar customers without determining the customer's specific identity (see below),** however, **the specification (disclosure) does not immediately support determining, as a function of the type of payment device used by the customer, a group associated with the customer independent of identifying the customer (i.e. without revealing the customer's identity) and direct the service equipment to provide services to the customer at a discounted price based, at least in part, on the determined group.** Indeed, the specification does not disclose what type of criteria were used to segment, classify, cluster, pair or group similar customers together and how a particular group is being identified in general or how a customer of a particular group of customers is being recognized, without revealing the customer's identity, at a point-of-sale using perhaps the group identity. Having said that, permitting the operator to focus on a particular group of customers for

increased sales or simply targeting a group of customers is a pure nominal recitation since no specific criteria, parameters or variables were used to form a group. To this end, targeting a group of customers simply means targeting a plurality of customers in general term. Thus, **directing the service equipment to provide services to the customer at a discounted price based, at least in part, on the determined group** is rather premature and is not supported since the criteria used to form or determine a group is not disclosed therein.

{The present embodiments of the invention provide a number of advantages. For example, the ability to identify customers and then provide services at a discounted price and/or free of charge regardless of whether the customers purchase any fuel provides a flexible and efficient manner in which to increase customer loyalty and thereby increase overall sales. Furthermore, the criteria by which the customers are provided with discounted and/or free services may be reprogrammed, thereby permitting the operator of the system to focus upon particular target **groups** of customers for increased sales.

[0052] In an alternative embodiment, during operation of the system 100, as illustrated in FIGS. 4, 4a, 4b, 4c, and 4d, the controller 110 implements a program 400 for providing discounted and/or free services to customers of the system in which the controller 110 determines the identity of the customer in step 402. In an exemplary embodiment, in step 402, the controller 110 determines the identity of the customer of the system 100 by the customer interfacing with the user interface 106 and the controller monitoring the user interface 106. **In an exemplary embodiment, the identity of the customer may include one or more of the following customer identity characteristics: (1) the name of the customer; (2) the type of payment device used by the customer; (3) the name of the issuer of the credit, debit, ATM, or smart card or payment transmitter; (4) the account number of the customer associated with the credit, debit, ATM, or smart card, or payment transmitter; (5) a unique alpha numeric customer identifier; (6) the biometrics for the customer; and other identity characteristics of the customer. As above, the identity of the customer can be determined in more general terms, for example, to group the customer together with other similar customers without determining the customer's specific identity. Thus, the identity of the customer can also be determined from information such as whether the customer pays with cash, by credit, debit, ATM, smart card, or payment transmitter, the benefits level (ex. standard, gold, or platinum) of the customer's credit, debit, ATM, or smart card, the existence of, or information gathered from, an RF, infrared, or other transmitter device associated with the customer, for example, an automatic tollway payment device or a transmitting identifier associated with the vehicle, and other general identity characteristics of the customer.**

[0065] The present embodiments of the invention provide a number of advantages. For example, the ability to identify customers and then provide services at a discounted price and/or free of charge provides a flexible and efficient manner in which to increase customer loyalty and thereby increase overall sales. Furthermore, the criteria by which the customers are provided with discounted and/or free services may be reprogrammed thereby permitting the operator of the system to focus upon particular target **groups** of customers for increased sales. Finally, because the system may assign adjustable weighting values to the customer identity characteristics, the operator of the system may precisely focus upon particular target customers in a flexible manner.

[0040] In an alternative embodiment, during operation of the system 100, as illustrated in FIGS. 3, 3a, 3b, 3c, 3d and 3e, the controller 110 implements a program 300 for providing discounted and/or free services to customers of the system in which the controller 110 determines the identity of the customer in step 302. In an exemplary embodiment, in step 302, the controller 110 determines the identity of the customer of the system 100 by the customer interfacing with the user interface 106 and the controller monitoring the user interface 106. In an exemplary embodiment, the identity of the customer may include one or more of the following customer identity characteristics: (1) the name of the customer; (2) the name of the issuer of the credit, debit, ATM, or smart card or payment transmitter; (3) the account number of the customer associated with the credit, debit, ATM, or smart card, or payment transmitter; (4) a unique alpha numeric customer identifier; (5) the biometrics for the customer, and other identity characteristics of the customer. The identity of the customer can be determined in more general terms, for example, to **group** the customer together with other similar customers without determining the customer's specific identity. Thus, the identity of the customer can also be determined from information such as whether the customer pays with cash, by credit, debit, ATM, smart card, or payment transmitter, the benefits level (ex. standard, gold, or platinum) of the customer's credit, debit, ATM, or smart card, the existence of, or information gathered from, an RF, infrared, or other transmitter device associated with the customer, for example, an automatic tollway payment device or a transmitting identifier associated with the vehicle, and other general identity characteristics of the customer.}

Excerpt from the PGPUB version of the Instant Application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9, 16 and 20 (including their dependent claims) are rejected under 35 U.S.C. 112, second paragraph, as being ambiguous or confusing. In fact, the claims recite

determining, as a function of the type of payment device used by the customer, a group

associated with the customer independent of identifying the customer (i.e. without revealing the customer's identity) and directing the service equipment to provide services to the customer at a discounted price based, at least in part, on the determined group (i.e. providing a discounted service to the customer based on the type of payment device used by the customer and based on the customer's association with a determined group without the revealing the customer's identity). However, as per the specification (see below), the type of payment device or payment instrument used by the customer during a transaction represents one of the identification means used to identify a customer during the transaction and provide a discounted service to the customer. Once a customer's payment device or payment instrument is used, the customer will be automatically identified. Hence, the claims become confusing for reciting the use of a payment device by the customer during a transaction and the customer's association with a group for making it unnecessary to reveal the customer's identity.

{[0052] In an alternative embodiment, during operation of the system 100, as illustrated in FIGS. 4, 4a, 4b, 4c, and 4d, the controller 110 implements a program 400 for providing discounted and/or free services to customers of the system in which the controller 110 determines the identity of the customer in step 402. In an exemplary embodiment, in step 402, the controller 110 determines the identity of the customer of the system 100 by the customer interfacing with the user interface 106 and the controller monitoring the user interface 106. **In an exemplary embodiment, the identity of the customer may include one or more of the following customer identity characteristics: (1) the name of the customer; (2) the type of payment device used by the customer; (3) the name of the issuer of the credit, debit, ATM, or smart card or payment transmitter; (4) the account number of the customer associated with the credit, debit, ATM, or smart card, or payment transmitter; (5) a unique alpha numeric customer identifier; (6) the biometrics for the customer; and other identity characteristics of the customer. As above, the identity of the customer can be determined in more general terms, for example, to group the customer together with other similar customers without determining the customer's specific identity. Thus, the identity of the customer can also be determined from information such as whether the customer pays with cash, by credit, debit, ATM, smart card, or payment transmitter, the benefits level (ex. standard, gold, or platinum) of the customer's credit, debit, ATM, or smart card, the existence of, or information gathered from, an RF, infrared, or other transmitter device associated with the customer, for example, an automatic tollway payment device or a**

transmitting identifier associated with the vehicle, and other general identity characteristics of the customer.}

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson, USP 6,813, 609B2.

As per claims 1-28, Wilson teaches a system or a fuel dispensing system including a fuel dispenser associated with a control system and a receiver adapted to receive signals, including identification indicia from a remote communications unit (transponder, handheld device, fob, etc.) associated with a customer when a cash, credit or pre-paid transaction is indicated within an establishment or gas station. A cash transaction indicator is adapted to signal the control system that a cash transaction (type or method of payment) is taking place, and may be selectable by the customer or an operator of the system at the beginning of the transaction. The system also includes a transmitter adapted to transmit the customer-related information to the remote communication unit (transponder) associated with the customer where it is locally stored or has memory for storing the customer-related information in association with the identification

indicia. The system is further configured to store credit for change due to the customer based on a cash transaction and provide and store loyalty points on or in association with the customer's transponder (See abstract).

The present system keeps track of cash customers and their respective refunds and loyalty points using transponder technology. Basically, a cash customer either carries a transponder or has a transponder mounted on his vehicle wherein the transponder is used to associate any refunds or loyalty benefits with the otherwise invisible cash customer. The operator can monitor the cash customer via the transponder. In practice, the customer uses the cash acceptor of the fuel dispenser and receives any change as credit with the transponder. The transponder may simply provide an ID where the central control system or a remote host network keeps track of the refund for later credit (i.e. the host computer stores the customer's credit or change due in a system database for later retrieval and use). Alternatively, the refund amount or credit may be transmitted directly to and stored on the transponder. In either embodiment, the amount stored in association with the transponder may be used as a credit during a subsequent fueling or retail purchase transaction (Col. 2: 6-19).

In addition to storing credit for the change due based on a cash transaction, loyalty points (promotions) are provided and stored on or in association with the transponder (loyalty points are stored in the memory of the transponder-Col. 2: 42-44).

Another aspect of the present system is a fuel dispenser system providing a customer input device, display and interrogator associated with a dispenser control system. The customer input device and display are adapted to provide a customer interface. The interrogator is adapted

to communicate with a remote communications unit associated with the customer. The customer interface is adapted to provide a cash transaction input for the customer to select a cash transaction. The control system is adapted to operate in conjunction with a remote control system to provide customer information associated with the remote communications unit (transponder) when a cash transaction is selected. The customer information may relate to change due a customer as a result of a cash transaction and/or loyalty benefits based on a cash transaction. The customer information may be stored on the remote communications unit or in association with a remote communications unit identifier in a database accessible by the control system. The control system may include a dispenser controller, central site controller, remote network control system or any combination thereof (col. 2: 52 to col. 3: 4).

Additionally, the present system is configured to provide various types of loyalty benefits **based on past and/or current transactions**. Loyalty benefits will be provided to a customer in order to encourage subsequent return to a particular fueling environment or one of an associated group of environments. The benefit may also encourage the purchase of additional products during the current or a subsequent transaction. The benefits may include cash rebates or discounts providing a type of electronic couponing to enhance merchandising and marketing efforts. A loyalty point may be earned by a customer for each transaction, transaction amount or type or quantity of a particular product or service. For example, a loyalty point may be earned for each gallon of gas purchased or for a fill-up requiring eight or more gallons of gas. The store operators have tremendous flexibility in determining the various criteria for earning loyalty points. Additionally, the loyalty benefits or points (stored in the customer's transponder memory) are preferably redeemed by a customer in part or in whole on subsequent visits to the same or an

associated fueling environment when the customer's presence is detected within an establishment via his transponder storing at least the customer's identification or indicia. Redeeming points at a subsequent transaction provides an incentive for a customer to return to environments participating in the benefit program. **Although redeeming points on a subsequent purchase is preferred, however, benefits may be made immediately available based solely on the current transaction, especially if the customer is using cash to pay for the transaction (wherein the benefits (discount coupon), provided during the current transaction, may be redeemed immediately on merchandise sold at convenience store 20, on car wash service available at remove car wash facility 24 and on food items sold at quick serve restaurant 22 of fig. 1 and wherein the remote car wash 24 equipment or terminal, the quick serve restaurant 22 equipment or terminal and the convenience store 20 equipment or terminal are coupled to the fuel dispensing system and wherein the benefits (coupon) may be encoded or stored on the customer's transponder for later use and the customer receives a printed receipt that he presents, for example, at the car wash facility 24 to receive the discounted car wash service, especially if the customer does not have or carry a transponder) (providing a free or fully discounted service or a car wash service to a targeted customer from a plurality of targeted customers or from a group of targeted customers...)**. Furthermore, the benefits may be based upon current and prior transactions and allow for both current and subsequent benefit (col. 13: 43 to col. 14: 58; col. 14: 59 to col. 15: 60; col. 8: 29 to col. 11: 4; figs. 1, 5 and 10C).

See col. 15: 63 to col. 19: 8; figs. 26A and 9; col. 11: 5-20.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Claims 16-19 and 20-28 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/24689 to Giordano.

As per claims 16-28, Giordano discloses a method of and a system for providing a fuel dispenser (14) with radio frequency customer identification capabilities via customers' transponders (wireless devices) mounted on vehicles or handheld (key chain, fob, etc.) transponders. The system and method determine whether a transponder (23, 25) containing customer identification data is within (proximity) range of a dispenser (14) that requires activation by the customer to initiate a transaction, such as a fuel transaction, and has an associated reader (20) for emitting radio frequency signals and receiving customer identification data from the transponder (23, 25) responsive to the emitted radio frequency signals (detecting the presence of a customer within a business establishment). When the transponder (23, 25) is within range of the dispenser, an in-range indication is provided to the customer. Upon activation of the dispenser (14) following a determination that the transponder (23, 25) is within range, the customer identification data (CID) received by the reader (20) is associated with a transaction at the activated dispenser. The transaction at the activated dispenser (14) is then permitted and charged to the customer's account according to the customer identification data as read from the transponder (once the customer is properly identified, the transaction is allowed according to a generated or pre-determined plan or the customer's account and the value of the transaction value or balance due is charged to the customer's account). Further, Giordano teaches providing loyalty benefits to the customer, based on the customer's profile (tracking or monitoring data or

purchase history), during the transaction conducted via the transponder or remote communication unit, in which the customer's account is charged accordingly.

Tracking data and/or business data and/or security data may be written to a R/W (read/write) transponder. Further, preference information related to the buying experience of the customer or buyer may be written to the memory of the transponder. The transponder can be connectable by a suitable interface to microprocessors such as a vehicle's on-board computer so that, in cooperation with the system (10), information, such as fuel economy calculations, miles traveled since the last fill up, engine conditions and the like, can be written to the transponder and then displayed to the customer while fueling.

Following a validation process, at the POS, a sale is permitted wherein the customer can dispense fuel and/or order goods, such as food, services, car wash at the pump, all which is charged to the customer's account identified by the transponder. The system may offer, by displaying a promotional message on a display (CAT) **terminal, to the customer a free car wash if the customer has purchased fuel a certain number of times (providing a free or fully discounted service or a car wash service to a targeted customer from a plurality of targeted customers or from a group of targeted customers...)**. Customer's information is stored in the system database. The system or host can also store a copy of the customer's information into the customer's transponder memory, which is periodically updated by the system.

Finally, the system or network keeps track of the customer's past purchases and buying preferences and provides rewards for frequent purchases. When a transponder is read at a business facility, the CAT or terminal, related to the fuel dispenser, can display a message

indicating rewards, **such as a free car wash, that the customer is entitled to**. The network or system also stores the customer's profile, such as name, address, payment account information, preferred method of payment, preferred language and so forth, and provides customized service for the customer based on the stored profile.

See abstract; figs 1-31; page 5: 9 to page 6: 17; page 13: 15 to page 24:16; page 30: 22-32; page 35: 32 to page 36: 20; page 55: 5-25.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft –571-273-8300 :

07/31/07

Jean D. Janvier

JDJ

Patent Examiner

Art Unit 3622

JEAN D. JANVIER
PRIMARY EXAMINER